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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,545	07/24/2003	Yasushi Ogiwara	059994-5001	8198
9629	7590	08/09/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			AMARI, ALESSANDRO V	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,545

Applicant(s)

OGIHARA, YASUSHI

Examiner

Alessandro V. Amari

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 9-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 14 is/are rejected.
- 7) ☒ Claim(s) 2-4, 8 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/24/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I, claims 2-4, 8 and 15 in the reply filed on 13 June 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 5-7 and 9-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Price US 5,932,872.

In regard to claim 1, Price teaches (see Figure 1, 4, 5) a microscope system comprising a stage (103) on which a specimen (114) is placed; an image forming optical system (see objective in Fig. 1) that forms an image of the specimen placed on the stage; an image-capturing device (108) that captures the image of the specimen formed by the image forming optical system; a focused position detection device (106, 112, 113) that detects focused position for the specimen based upon the specimen image captured by the image-capturing device; and a focused position storage device (a part

Art Unit: 2872

of element 112) that stores in memory the focused position detected by the focused position detection device as described in column 9, lines 43-45, wherein the focused position detection device sets a search range centered around the focused position stored in memory at the focused position storage device and detects the focused position anew by causing the stage and the image forming optical system to move relative to each other over the search range thus set each time a focusing operation is executed as shown in Figures 4 and 5 and as described in column 9, lines 22-67 and column 10, lines 1-36.

In regard to claim 14, Price teaches (see Figure 1, 4, 5) an autofocus control method adopted comprising capturing an image of a specimen (114) placed on a slide glass as described in column 7, lines 13-36, mounted on a stage (103); detecting a focused position (via 106, 112, 113) for the specimen relative to an objective lens (see objective in Fig. 1) by using the captured image of the specimen; storing the focused position into memory at a storage device as described in column 9, lines 43-45; detecting the focused position anew by moving the stage and the objective lens relative to each other within a search range centered around the focused position stored in the storage device when an instruction for a focusing operation start is issued as shown in Figures 4 and 5 and as described in column 9, lines 22-67 and column 10, lines 1-36.

Allowable Subject Matter

4. Claims 2, 3, 4, 8 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 2872

5. Claim 2 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "the focused position detection device sets the search range based upon the same focused position stored in memory at the focused position storage device every time a focusing operation is executed until the reset operation is detected by the reset operation detection device" as set forth in the claimed combination. Claims 3, 4 and 8 are also allowable based upon their dependence on claim 2.

Claim 15 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "information indicating the focused position stored in the storage device is erased once the slide glass is moved off an optical axis of the objective lens" as set forth in the claimed combination.

The prior art of record, Price teaches a microscope system comprising a stage, an image forming optical system, an image capturing device, a focused position detection device, a focused position storage device and a focused position detection device wherein the focused position detection device sets a search range centered around the focused position stored in memory at the focused position storage device and detects the focused position anew by causing the stage and the image forming optical system to move relative to each other over the search range thus set each time a focusing operation is executed. However, the prior art of record does not teach that the focused position detection device sets the search range based upon the same focused position stored in memory at the focused position storage device every time a focusing operation is executed until the reset operation is detected by the reset

operation detection device or that information indicating the focused position stored in the storage device is erased once the slide glass is moved off an optical axis of the objective lens and there is no motivation or teaching to modify this difference as derived.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Karlsson et al US 20040114218 teaches an autofocus control method.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/625,545
Art Unit: 2872

Page 6

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01 August 2005

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